UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,965	12/15/2003	Christopher Kent Karstens	RSW920030208US1	3393

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.
10/735,965</td><td>Applicant(s)
KARSTENS, CHRISTOPHER KENT</td></tr>
<tr><td>Examiner
Abdelnabi O. Musa</td><td>Art Unit
2109</td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>15 December 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-30</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-30</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>15 December 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/15/2003, 10/27/2006</u>.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

1.   The instant application having Application No. 10/735965 has a total of 30 claims

pending in the application; there are 5 independent claims and 25 dependent claims, all

of which are ready for examination by the examiner.

Oath/Declaration

2.   The applicant's oath/declaration has been reviewed by the examiner and is found

to conform to the requirements prescribed in **37 C.F.R. 1.63.**

Priority

3.   As required by **M.P.E.P. 201.14(c)**, acknowledgement is made of applicant's

claim for priority based on applications filed on December 15, 2003.

Information Disclosure Statement

4.   As required by **M.P.E.P. 609(C)**, the applicant's submissions of the Information

Disclosure Statements dated October 27, 2006, December 15, 2003. Is acknowledged

by the examiner and the cited references have been considered in the examination of

the claims now pending. As required by **M.P.E.P 609 C (2)**, a copy of the PTOL-1449

initialed and dated by the examiner is attached to the instant office action.

Title

5.   The title of the invention is not descriptive. A new title is required that is clearly

indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form

the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless – .
> (e) The invention was described in (1) an application for patent, published under section 122(b),
> by another filed in the United States before the invention by the applicant for patent or (2) a
> patent granted on an application for patent by another filed in the United States before the
> invention by the applicant for patent, except that an international application filed under the treaty
> defined in section 351(a) shall have the effects for purposes of this subsection of an application
> filed in the United States only if the international application designated the United States and
> was published under Article 21(2) of such treaty in the English language.

6.   Claim(s) 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Szeto

Patent No.: (US 7,188,143 B2)

As per claim 1, Szeto teaches a computer-readable medium (a computer

readable medium such as a computer readable storage Col. 3, Line 5) whose contents

cause a source computer to control the use of content carried over a content controlled

instant message session with a target computer, (technologies for controlling an

application in an instant messaging environment are described, Abstract; Col. 1, Line

21) the source computer having a program for performing the (program instruction

within the storage medium computer Col. 3, Line 7; program to communicate with users

Col. 8, Line 24) steps of:

determining a requested use attribute for instant message content generated by the source computer (the instant messaging environment can request and retrieve applications and instant messages based on the identifier 'from both clients and users' Col. 3, Line 1);

sending the requested use attribute to the target computer (the control message is sent to IM clients which implements the requested IM applications Col. 13, Line 53);

receiving an indication verifying whether a content controlled instant message session is supported at the target computer (a code or signature is used to verify the integrity of the environment Col. 8, Line 65) ; and

establishing the content controlled instant message session having a session use attribute based upon the requested use attribute with the received indication (a control message for sending and receiving the message and selecting an IM environment to execute the applications Col. 3, Line 28; FIG. 4), the content controlled instant message session controlling the use of content provided over the session at the target computer in accordance with the session use attribute (user interface commands that control the content and the display of the IM application between the user and the client Col. 5, Line 36. FIG. 2; instant messaging server that interact between a client and a user Col. Col. 6, Line 6).

As per claim 2, Szeto teaches a the computer-readable medium of claim 1 (a computer readable medium such as a computer readable storage Col. 3, Line 5) wherein the received indication further includes an indication that a use content feature on the target computer corresponding to the requested use attribute has been activated.

(an environment in the instant messaging system that gives the user options to activate and indicate the user content features on the client side Col. 1, Line 40; FIG. 1; start function for IM window activation Col. 9, Line 35; FIG. 5).

As per claim 3, Szeto teaches the computer-readable medium of claim 2 (a computer readable medium such as a computer readable storage Col. 3, Line 5) wherein the use content feature is a disabled printing function, a disabled screen capture function (user interface function controlling IM applications were a monitor screen has containing the history window Col. 13, Line 56), a disabled third party join function (using a third party servers for instant messaging Col. 4, Line 8; Col. 12, Line 36; FIGs 10), a disabled clipboard copy function, or a disabled logging function at the target computer (Instant messaging servers may perform various functions for communications and conversions Col. 1, Line 32; Col. 1, Line 48; Col. 5, Line 46; FIG. 1, 3).

As per claim 4, Szeto teaches considered the computer-readable medium of claim 1 (a computer readable medium such as a computer readable storage Col. 3, Line 5) wherein the establishing step further comprises the steps:

modifying the requested use attribute (one environment in an instant messaging server may modify the request Col. 8, Line 25; Col. 7, Line 11; Col. 10, Line 66);

sending the modified use attribute (sending instant messaging environment Col. 2, Line 41; Col. 3, Line 28); and

receiving a confirmation of the modified use attribute from the target computer to establish the content controlled instant message session, the session use attribute

based upon the modified use attribute (an identifier is assigned to the instant messaging applications that is executed in the environment between the clients, Abstract; Col. 1, Line 42; Col. 6, Line 14; FIG. 4)

As per claim 5, Szeto teaches the computer-readable medium of claim 1 (a computer readable medium such as a computer readable storage Col. 3, Line 5) further comprising:

updating the session use attribute during communication over the content controlled instant message session after the establishing of the content controlled instant message session step (the instant messaging server retrieves and updates the client's environment from the network Col. 6, Line 34; Col. 9, Line 49).

As per claim 6, Szeto teaches a computer-readable medium (a computer readable medium such as a computer readable storage Col. 3, Line 5) whose contents cause a source computer to control the use of content carried over a content controlled instant message session to a target computer (the instant messages and content are downloaded and controlled from a central source to the clients Col. 10, Line 34; FIGs. 10), the target computer having a program (program instruction within the storage medium computer Col. 3, Line 7; program to communicate with users Col. 8, Line 24) for performing the steps of:

receiving a first message containing a first requested use attribute from the source computer (the control message is sent to a client requesting the IM application Col. 13, Line 53; FIG. 13);

reading the first requested use attribute (the messaging environment can read

the information available to client Col. 12, Line 5; FIGs. 9);

determining whether a content use feature corresponding to the first requested

use attribute is supported on the target computer (the instant messaging environment

determines whether a supporting application is required Col. Abstract; Col. 2, Line 57;

Col. 13, Line 8; FIGs. 12); and

sending a second message indicating the support of the content use feature to

the source computer (a sending instant messaging environment identifying the

application status Col. 2, Line 41; when first client is identified and supported the control

message sends sets a message to a second client and executing the application in the

messaging environment Col. 3, Line 16-35; Col. 5, Line 40).

As per claim 7, Szeto teaches the computer-readable medium of claim 6 (a

computer readable medium such as a computer readable storage Col. 3, Line 5)

wherein the program further comprises the step of: activating the content use feature on

the target computer (an environment in the instant messaging system that gives the

user options to activate and indicate the user content features on the client side Col. 1,

Line 40; FIG. 1; start function for IM window activation Col. 9, Line 35; FIG. 5).

As per claim 9, Szeto teaches the computer-readable medium of claim 6 (a

computer readable medium such as a computer readable storage Col. 3, Line 5)

wherein the second message includes a first unsupported use attribute (the instant

messaging environment determines whether a supporting application is required Col.

Abstract; Col. 2, Line 57; Col. 13, Line 8; FIGs. 12), the first unsupported use attribute

defining the feature on the target computer which may not be activated (an environment

in the instant messaging system that gives the user options to activate and indicate the

user content features on the client side Col. 1, Line 40; FIG. 1; start function for IM

window activation Col. 9, Line 35; FIG. 5).

As per claim 10, Szeto teaches the computer-readable medium of claim 6 (a

computer readable medium such as a computer readable storage Col. 3, Line 5)

wherein the program (program instruction within the storage medium computer Col. 3,

Line 7; program to communicate with users Col. 8, Line 24) further comprising the steps

of:

determining a second requested use attribute for instant message content

generated by the target computer (the instant messaging environment can request and

retrieve applications and instant messages based on the identifier 'from both clients

and users' Col. 3, Line 1), the second requested use attribute corresponding to a

second content use feature (user interface displays instant messages and their

corresponding environment to the user from the client Col. 5, Line 39; Col. 6, Line 23);

sending the second requested use attribute to the source computer (the control

message is sent to IM clients from the source computer which implements the

requested IM applications Col. 13, Line 53);

receiving at the source computer an activation indication of the second content

use feature (a code or signature is used to verify the integrity of the environment Col. 8,

Line 65); and sending an instant message having content controlled by the second

content use feature (technologies for controlling an application in a n instant messaging environment, Abstract; Col. 1, Line 21).

As per claim 11, Szeto teaches the computer-readable medium of claim 6 (a computer readable medium such as a computer readable storage Col. 3, Line 5) further comprising the step of:

updating the first requested use attribute (the instant messaging server retrieves and updates the client's environment from the network Col. 6, Line 34; Col. 9, Line 49)

As per claim 12, Szeto teaches the computer-readable medium of claim 10 (a computer readable medium such as a computer readable storage Col. 3, Line 5) further comprising the step of:

updating the second requested use attribute (the instant messaging server retrieves and updates the client's environment from the network Col. 6, Line 34; Col. 9, Line 49)

As per claim 13, Szeto teaches a computer-readable medium (a computer readable medium such as a computer readable storage Col. 3, Line 5) whose contents cause a computer system to control the use of content over a content controlled instant message session (technologies for controlling an application in a n instant messaging environment are described, Abstract; Col. 1, Line 21), the computer system having a source computer having a source program and a target computer having a target program, the target program having access to disabling a content use feature on the target computer (program instruction within the storage medium computer Col. 3, Line

7; program to communicate with users Col. 8, Line 24; program control or environment

program Col. 6, Line 40; Col. 9, Line 51), by performing the steps of:

sending a requested use attribute for instant message content generated by the

source program (the control message is sent to IM clients which implements the

requested IM applications Col. 13, Line 53);

receiving the requested use attribute at the target program (the control message

is sent to a client requesting the IM application Col. 13, Line 53; FIG. 13);

determining whether a content use feature corresponding to the requested use

attribute is supported (user interface displays instant messages and their corresponding

environment to the user from the client Col. 5, Line 39; Col. 6, Line 23);

receiving at the source computer an indication of whether the content use feature

is supported (a code or signature is used to verify the integrity of the environment Col.

8, Line 65); and

establishing the content controlled instant message session having a session use

attribute defining the content use feature (a control message for sending and receiving

the message and selecting an IM environment to execute the applications Col. 3, Line

28; FIG. 4)

As per claim 15, Szeto teaches the computer-readable medium of claim 13 (a

computer readable medium such as a computer readable storage Col. 3, Line 5) further

comprising the following step before the receiving an indication step (a code or

signature is used to verify the integrity of the environment Col. 8, Line 65), the following

step comprising:

determining a second requested use attribute to control content sent by the

target program (the instant messaging environment can request and retrieve

applications and instant messages based on the identifier 'from both clients and users'

Col. 3, Line 1)

Regarding claims 8, 14, and 16-30 are related to the same limitation set for

hereinabove, where the difference used is the phrase 'method' in most of the claims.

The citations from the prior art has been inserted where's necessary. Furthermore, the

wordings of the claims were interchanged within the claim itself and this change does

NOT effect the limitation of the above treated claims. The claim's limitations seemed to

be repeated in many claims throughout the application. Even in the above treated

claims many of the statements were just repeated from previously written claims within

the application. Even though claims 8, 14, 16-30 have been differently written from the

above treated claims, yet the limitations did not change. As mentioned, claim 8 is the

same as claim 3, claim 14 is the same as claim 7, claim 16 is the same as claim 3,

claim 17 is the same as claim 4, claim 18 is the same as claim 5, claim 19 is the same

as claim 1, claim 20 is the same as claim 2, claim 21 is the same as claim 3, claim 22 is

the same as claim 4, claim 23 is the same as claim 5, claim 24 is the same as claim 6,

claim 25 is the same as claim 7, claim 26 is the same as claim 8, claim 27 is the same

as claim 9, claim 28 is the same as claim 10, claim 29 is the same as claim 11, claim 30

is the same as claim 12. a repeated minor difference was introduced between claims 8,

14, 16-30 and the above treated ones that did NOT change the limitations is that, for

example, sending a request from the client is the same as sending a request from the

source where the process is done by a server and instruction code, again there are no

difference in limitations between claims 8, 14, and 16-30 and the above treated claims.

Conclusion

The following prior art made of record and not relied upon is cited to establish the

level of skill in the applicant's art and those arts considered reasonably pertinent to

applicant's disclosure. See **MPEP 707.05(c)**.

The following are analogous art because they are from the same field of

endeavor of instant messaging and information controlling:

- Patil et al. Pub. No.: (US- 20020120691 A1)

- Whitten, II Patent No.: (US-6,993,564 B2)

- Kay et al. Patent No.: (US- 6430602 B1)

- Szeto et al. Patent No.: (US- 7120672 B1)

The examiner requests, in response to this Office action, support should be shown for

language added to any original claims on amendment and any new claims. That is,

indicate support for newly added claim language by specifically pointing to page(s) and

line(s) in the specification and/or drawing figure(s). This will assist the examiner in
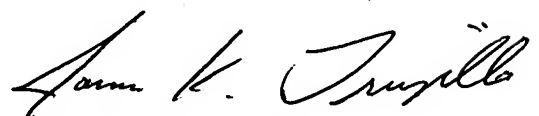
prosecuting the application.

When responding to this office action, Applicant is advised to clearly point out the patentable novelty which he or she thinks the claims present, in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections See 37 CFR 1.111(c).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdelnabi O. Musa whose telephone number is 571-2701901. The examiner can normally be reached on Monday Thru Friday: 7:30am to 5:00pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Pwu can be reached on 571-2726798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A.M

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PRIMARY EXAMINER
TC 2100